IN THE

Supreme Court of the United States

October Term, 1943

No. 455

LEROY J. LIEBERMAN,

Petitioner,

vs.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

PETITION FOR WRIT OF CERTIORARI

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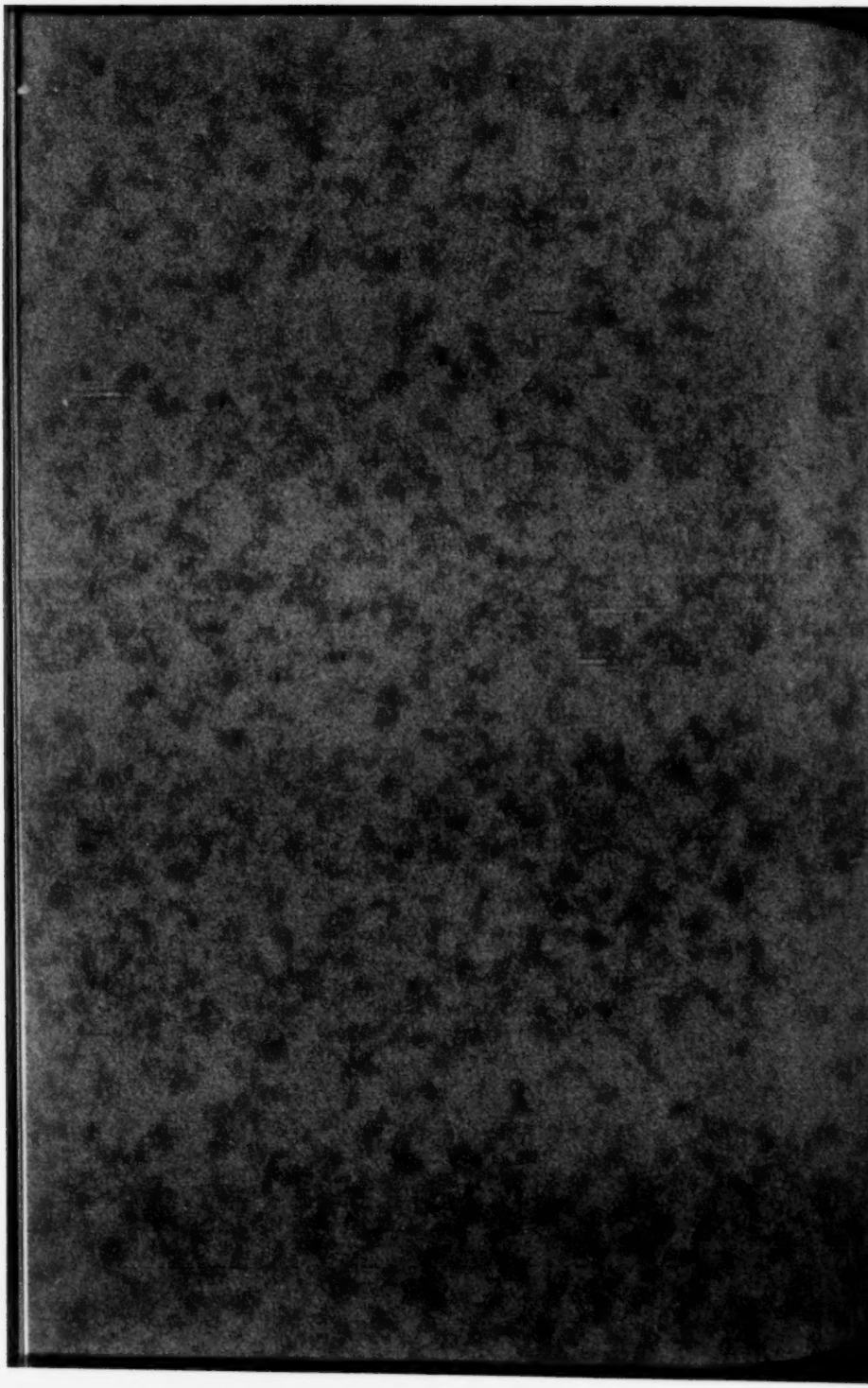

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REPLY BRIEF.

Introduction.

The Petition for a Writ of Certiorari filed by petitioner on October 25, 1943, was based primarily upon two grounds: first, that there was a conflict between the Ninth Circuit decision in the present case and that of the Second Circuit in the case of *Monogram Mfg. Co. v. Glemby Co., Inc., et al.*, 136 F. (2d) 961; and second, that this Honorable Court has never passed upon whether, in determining what a patentee intended to cover *in his original patent* it is proper for a court to place an artificial construction upon such original patent by purposely treating it as if one

of its claims had never been included because the claim was disclaimed from the reissue.

Respondent's brief makes no attempt to defend the ignoring of an original claim on such grounds, but tries to minimize the importance of the principle of patent law that is involved by stating (p. 8): "Whether there is any exception to this rule (that a disclaimer speaks from the date of the original patent) is perhaps an interesting speculation." Respondent then argues that even if the Circuit Court had considered original claim 5 in comparing the original and reissue patents, the result would have been the same, and that claim 5, like the other original claims, includes a lever.[1]

In interpreting claim 5 in a manner to make it appear that petitioner regarded a lever as an essential means for mounting and operating the tappet, respondent has ignored a part of the claim with which its interpretation cannot be reconciled. Inasmuch as respondent bases its opposition to the granting of the petition chiefly on such interpretation of claim 5, petitioner feels that the demonstrable errors in respondent's misconstruction should be pointed out; and this belief is the chief reason for filing this reply brief.

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[1]Evidently the Circuit Court did not think so, for it took pains to point out that in arriving at its decision it had ignored original claim 5.

Claim 5 Did Not Include a Lever as an Element.

Respondent tries to make it appear that the term "means movable about a pivot" applies to the lever F. This full term from the claim reads: "means movable about a pivot and acting upon operation in one direction (downward) to slidably engage either arm of said rocker and push it in one direction to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker." This language cannot possibly refer to the lever, for it is the tappet, and not the lever, that engages either arm of the rocker and pushes it; and it is also the tappet, and not the lever, with which the other arm of the rocker collides.

It is also significant that none of the other claims of the patent refer to the lever F as being "pivoted" or "mounted upon a pivot," and that in selecting the terminology to be applied to the mounting of the various members, the term "pivoted" is reserved as one of the alternative ways of describing the mounting of the rocker, the locking lever 66 that is pivoted upon lever F, and the tappet itself. In claims 1 and 2 [R. Vol. III, p. 510], the tappets are referred to as "adjustable members *pivoted.*" In claim 3, the tappet is "pivotally mounted"; but in *none* of the claim is the lever F referred to in such a manner.

In a further misconstruction to make "the means movable about a pivot" appear to be the lever F, respondent's brief (p. 5) says: "The tappet cannot and must not be movable about its pivot during the act of tuning, for if it

is, it cannot move the rocker. The only means which is or can be movable about a pivot during tuning is the lever assembly comprising the lever F moving on the pivot Q."

There is nothing about the term "means movable about a pivot" that says such movement takes place during tuning. The tappet must be movable about its pivot for adjustment purposes.

In its concluding item of misconstruction (also p. 5), respondent says: "Further, the claim calls for 'a spring for holding *said means* in a normally inoperative position.' The spring 73 engages the lever F, not the tappet 61."

The claim does not say the spring *engages* the "means movable about a pivot." Inasmuch as the spring does not need to be attached to the tappet, the spring is merely defined as "for holding said means in a normally inoperative position." This is exactly what the spring does. The tappet must normally be in an inoperative position out of engagement with the rocker, and the spring is for holding it there.

It should be clear from what has been said in this and the previous briefs that the Circuit Court could not have stated that "No leverless combination is disclosed or claimed in the original patent" if claim 5 had been taken into consideration, and that such a holding is explained by the Circuit Court's own statement that "the patent is construed as if claim 5 had never been included therein."

The principle of patent law here involved has never been passed upon by this Honorable Court, and the Circuit

Court's ignoring of this claim in determining petitioner's intent is an unwarranted misapplication of the doctrine of the *Altoona* case, as pointed out in the petition.

Regarding the Equivalency of a Lever and a Plunger.

Respondent's statements as to the equivalency of a lever and a plunger apparently have no bearing upon the grounds advanced by petitioner for the granting of the petition and are pertinent only to the ultimate matter of whether there is infringement of the claims that include the manual operating member as an element of the combination. (Claims 7 and 8 are drawn to what the District Court called "the essential elements" and do not include the manual operating member as an element of the combination.) Petitioner will therefore merely point out at this time that respondent has imported a much broader scope into the Circuit Court's statement as to the equivalency of the lever and a plunger than the decision justifies.

Says respondent's brief (p. 10): "The Court of Appeals here held that levers and plungers are not equivalents, and this is complained of by Petitioner. There are many reasons why plungers are not the equivalent of levers . . ." On the same page, respondent's brief further says: "But in any case, concurrent findings by the District Court and the Court of Appeals that plungers and levers are not equivalents, give no basis for review by certiorari."

Neither the District Court nor the Court of Appeals ruled that levers and plungers *per se* are not equivalents.[2]

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[2]As the District Court pointed out (see the petition, bottom page 4 to top page 5), the rocker and tappet and their coaxial relationship in the tuned-in position are "the essential elements in the plaintiff's structure." The manual operating member (lever or plunger) merely serves to guide and transmit motion to the tappet. A plunger or lever thus serves the same function in the tuning device that a handle serves on a pump, and the Circuit Court did not dispute their equivalency *per se*, but differentiated them because of the number of tappets operated. Inasmuch as it has been shown from the patent that petitioner intended to use either one or two tappets optionally, respondent's contention that its use of a plunger relieves it of infringement (respondent's brief, p. 2) is like a pump manufacturer contending that it has avoided infringement of a pump patent by using a different type of handle—by using a plunger instead of the lever type of handle to operate the mechanism.

Respondent is wrong in inferring that the Circuit Court of Appeals held that in every instance levers and plungers are not equivalents. On the contrary, every court that has actually considered the matter as far as petitioner has been able to learn has held that they *are* equivalents.

In *Blake v. Robertson*, 94 U. S. 728, 732, 733, 24 L. ed. 245, this Honorable Court held that a pump and piston (plunger) were the mechanical equivalents of a vibrating arm (lever), toggle joint, and other mechanical devices, used in transmitting power.

The equivalency of such members is also asserted in *Bundy Mfg. Co. v. Detroit Time-Register Co.*, 94 F. 524 (C. C. A. 6), in which the court, at page 538, said.

> "* * * Whether his key actuated the feeding and printing mechanism by being turned (as is a lever) or pushed (as by a plunger) is not of the essence of the invention. Pushing keys (plungers) setting in motion bolts and other mechanisms were old, and but the equivalents of keys which did the same thing by turning."

In *New Departure Bell Co. v. Hardware Specialty Co.*, 69 F. 152 (C. C., N. J.), the court adjudicated specifically that a *push bar* is the equivalent of a *lever* (p. 156):

> "* * * In this patent is to be found all the elements of this Rockwell claim, combined and operating in substantially the same way and for the same purpose, with the single exception that the *operative push bar* of the French patent—*of which the lever of the claim is the manifest mechanical equivalent*—has a vertiaction instead of a horizontal movement." (Emphasis added.)

The District Court did not take up this matter, and the Court of Appeals merely held that respondent's plungers were not the equivalent of petitioner's levers because, said the Court of Appeals [R. Vol. V, pp. 715-716]: "The plungers perform a part, and only a part, of the function performed by appellant's levers F and 66. The part so performed is not performed in the same way, or in substantially the same way." In its footnote 17, the Circuit Court explains this holding by saying: "Appellant's levers have a double function—that of operating the tappet 61 and that of operating the tappet 62. The latter function is not performed at all in the accused device."

The distinction drawn by the Circuit Court was thus not directed to plungers and levers *per se*, but to the fact that petitioner's operating member operates two tappets while that of respondent operates only one. This was the only reason advanced by the Circuit Court for its holding that the two structures were not equivalents, and petitioner complained that this was not a valid distinction because the patent specifically states that one of the objects is "to make it possible for a single manual operation to tune either a radio set or a television set, or both." The patentee thus contemplated using either one or two tappets, depending upon whether the manufacturer desires to tune only a radio set or a television set, or both. Furthermore, it cannot be disputed that the device was claimed with only a single tappet *in the original patent* in claim 5 and in claims 7 to 11 of the reissue patent, as well as in reissue claim 5 which was later disclaimed. Respondent's use of

a single tappet is thus exactly what the patent specifically provided for.

Even if the patent had not expressly made this provision, the use of a single tappet would not relieve respondent of his responsibility according to this Honorable Court's doctrine in *Hobbs v. Beach,* quoted on page 22 of petitioner's brief in support of his petition.

The Conflict Between the Ninth and Second Circuit Courts of Appeal.

The conflict between the opinions of the Ninth and Second Circuit Courts of Appeal, which petitioner believes is a sufficient reason by itself for granting the petition, is glaringly manifest on page 9 of respondent's brief where respondent justifies the Second Circuit decision respecting precisely the same issues and a set of facts that are about as closely parallel as they could possibly be.

Says the respondent:

> "* * * In that (the Glemby) case the claims of the original patent related to a hair curler which had been shown with a spring in the drawings, and had been described with a spring in the specification. By reissue some claims were secured which omitted the spring. The spring, of course, was not necessary to the operation of the device."

In the instant case, the original patent related to a tuner which had been shown with a lever in the drawings, and had been described with a lever in the specification. By reissue some claims were secured which like original claim 5 omitted the lever. The lever, of course, was not an

essential means of operating the tappet, as respondent itself has shown by its use of a well-known mechanical equivalent; in fact, long before the Supreme Court rendered its *U. S. Industrial Chemicals* decision and discussed *essential* elements, the District Court in the present case, in discussing respondent's use of petitioner's combination, saw fit to enumerate what it called "the essential elements," and in this enumeration the lever was not included.

"The stated objects of the invention," continues respondent's discussion of the *Glemby* case on page 9, "concerned themselves with functions to which the spring was not vital. While a spring had been shown and described, the specification *stated* that the patentee had no intention of confining himself to the details of the exemplary embodiments shown. One of the *original* claims (claim 4) was not limited to a spring. Moreover, there was in that case a very real showing of inadvertence, accident and mistake."

In the instant case the stated objects of the invention likewise concerned themselves with functions to which a lever was not vital, as pointed out on page 11 of the petition and in footnote 6 on page 13. While a lever had been shown and described, the specification *stated* that "modifications may be made from the automatic tuning systems and devices herein described without departing from the general nature and purpose of the invention." One of the original claims (claim 5) was not limited to a lever. Moreover, there was in this case a very real showing of inadvertence, accident and mistake in that no single tappet and rocker claims like claim 5 had been included that expressed the coaxial relationship shown in the drawings of the original patent and stressed on page 2, column 1, lines 30 *et seq.* thereof, although this relationship had been ex-

pressed in other language in claims 1 and 2 by setting forth the relations between the pivot points of the tappets and the axis of the rocker with respect to the fulcrum of the operating lever.

In the concluding paragraph on page 9 respondent says:

> "That a patentee, who, through inadvertence, accident and mistake, has claimed a mechanical device with the inclusion of an obviously unnecessary element, should be permitted by reissue to eliminate that element from certain claims, seems not unfair and is not in contravention of any of the pronouncements of this Court in the *Industrial Chemicals* case, in view of the circumstances found as facts by the Second Circuit."

That the instant patentee who had a claim in his original patent directed to the essential elements and therefore omitting the lever, should be permitted in his reissue likewise to omit the lever from the new claims, seems also *not unfair;* BUT IN HIS CASE THE CONFLICTING OPINION OF THE NINTH CIRCUIT COURT SAYS THAT IF THE CLAIMS "DO NOT INCLUDE LEVERS, THE CLAIMS ARE NOT FOR THE SAME INVENTION AS THE ORIGINAL PATENT AND HENCE ARE INVALID."

Conclusion.

Clearly there is a conflict between the decisions of these two Circuit Courts of Appeal that constitutes ample grounds for the granting of the petition; and, moreover, the action of the Ninth Circuit Court of Appeals in determining intent by construing an original patent as if one of its claims had never been included, on the ground that it was later disclaimed from the reissue, is an unwarranted and artificial extension of the doctrine expounded in the *Altoona* case that can have serious consequences.

In the instant case, this ignoring of an original claim in determining the intent of the patentee, has already had *two* serious consequences: First, it nullified the effect of part of the evidence which showed that the patentee had no intention of limiting himself to a lever as an operating member and it led the Circuit Court to decide that the reissue was not for the same invention; and second, it nullified the effect of part of the evidence which showed that the patentee intended the operating member to carry either one or two tappets, and was a factor in leading the Circuit Court to conclude that levers and plungers, which are otherwise equivalents, were not equivalents in this case because the operating member of the accused device operates a single tappet.

It is respectfully submitted that the conflict with the Second Circuit Court of Appeals on the one hand, and the distortion of the *Altoona* doctrine on the other, are matters that call for the exercise by this Court of its supervisory powers by granting the petition for a writ of certiorari and thereafter reviewing and reversing the decision complained of.

Respectfully submitted,

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